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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/293,509	04/15/99	OSAWA	A RM.HPN WC

EXAMINER

QM12/0509

RAPHAEL A MONSANTO
ROHM & MONSANTO PLC
660 WOODWARD AVE SUITE 1525
DETROIT MI 48226

WHITE,C

ART UNIT	PAPER NUMBER
3713	3

DATE MAILED: 05/09/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)	
	09/293,509	OSAWA, AKIRA	
	Examiner	Art Unit	
	Carmen D. White	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)☒ All b)☐ Some * c)☐ None of the CERTIFIED copies of the priority documents have been:

1.☒ received.

2.☐ received in Application No. (Series Code / Serial Number) _____ .

3.☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

14) ☒ Notice of References Cited (PTO-892)
15) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
16) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
17) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
18) ☐ Notice of Informal Patent Application (PTO-152)
19) ☐ Other: .

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 09/268,960. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims of the instant claimed invention are drawn to a gaming machine that has a primary game and a secondary game that achieves the same objective as the claimed invention of copending Application No. 09/268,960. The claim language of the instant application is not exactly the same as that of Application No. 09/268,960. However, the invention of the instant application achieves all the same functions as the instant invention of Application No. 09/268,960.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-8 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Marnell, II (5,393,057) or Farrell (GB 2242300A).

Regarding claim 1, Marnell, II, or Farrell discloses a variable display for displaying graphical information corresponding to graphical elements necessary for a principal game; a controller for causing the variable display to display the graphical information; and a secondary display for displaying an image that is necessary for playing a secondary game that is different from the principal game, the secondary display displaying the image when the principal game results in one of a plurality of playing states (Marnell, II-col. 2, lines 35-51; col. 3, lines 1-9; Fig. 2; Farrell- Fig. 1; #57).

Regarding claims 2-4, Marnell, II or Farrell further discloses the secondary display indicating symbol images that correspond to a respectively associated one of the principal game playing states (Marnell II-abstract; Farrell- Fig. 1, #6, #2; #57).

Regarding claims 5-7, Marnell, II or Farrell further discloses providing an award to a player when the secondary display screen satisfies a predetermined condition (Marnell II- col. 7, lines 7-14; Farrell- Fig. 1, #9 and page 9, lines 25-34).

Regarding claim 8, Marnell, II or Farrell further discloses the resetting of the secondary display (Marnell II- col. 7, lines 25-34 and col. 6, lines 23-27; Farrell- page 12, lines 20-25).

Regarding claim 14, Marnell II further discloses the primary game being a slot game and a poker game (Fig. 1 and Fig. 2).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marnell, II (5,393,057) or Farrell (GB 2242300A).

Regarding claims 9-12, Marnell, II or Farrell discloses all the elements of the claims as discussed above. While Marnell II teaches the clearing of all of the display areas Marnell II is silent on disclosing the clearing of a single display area. Farrell discloses resetting the display screen or holding some of the display areas for another game (p. 12, lines 20-30). However, it would be an obvious design choice to clear either one or all areas according to whether or not the player wanted to maintain some

symbol positions in order to increase the player's chances of winning in subsequent games. Therefore, it would have been obvious to include this feature in Marnell II or Farrell.

7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marnell, II (5,393,057) or Farrell (GB 2242300A) in view of Wilson, Jr. et al (6,004,207) or Adams (5,848,932).

Regarding claim 13, Marnell II or Farrell discloses all the limitations of the claim as discussed above. Marnell II or Farrell lacks disclosing a multiplied payout. In an analogous gaming machine, Wilson Jr. et al or Adams discloses the multiplication of a payout value (Wilson Jr. et al- abstract; Adams- abstract). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature in Marnell II or Farrell because it is well known in the art to provide multiplied payouts in slot machines to increase players' interests in the game.

Citation of Pertinent Prior Art

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following references discloses gaming machines with primary and secondary game features:

Vancura (6,033,307)

Barrie (5,980,384)

Fraley (4,712,799)

Weiss (5,772,509)

Wain (GB 2222712A)

Sunaga (5,984,781)

Contact Information

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carmen D. White whose telephone number is 703-308-5275. The examiner can normally be reached on Monday-Friday, 8:30 am- 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703-308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7768 for regular communications and 703-308-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.

Carmen White
Patent Examiner

May 4, 2000

JESSICA J. HARRISON
PRIMARY EXAMINER